

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Sean Geoffrey MADDOX

Serial Number: 10/540,326

Filed: 22 January 2006

For: APPARATUS FOR RELEASING
MAGNETIC SECURITY DEVICE

Examiner: Christopher J. BOSWELL

Group Art Unit: 3673

Attorney Docket Number: 0188-USPCT

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/Donald G. Bauer/
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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant herein appeals the final rejection of claims 15-23, 27, 28 and 33 of the above-referenced patent application. Applicant also petitions for a one month extension and pays the \$130 fee.

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(i) **Real Party in Interest.**

The real party in interest in this Appeal is DuBois Limited, having a place of business at Amaray House, Arkwright Road, Corby, Northants, United Kingdom NN17 5AE501, by assignment recorded on January 17, 2006 at Reel/Frame 017023/0743. DuBois Limited is a subsidiary of MeadWestvaco Corporation, having a place of business at 501 South 5th Street, Richmond, Virginia, 23219.

(ii) **Related Appeals and Interferences.**

Applicant is unaware of any related appeals and interferences.

(iii) **Status of Claims.**

Claims 1 -- 14 and 32 are cancelled.

Claims 15 – 31 and 33 are pending in the application.

Claims 15-23, 27- 28, and 33 have been finally rejected.

Claims 29 – 31 are allowed.

Claims 24 - 26 are objected to.

The final rejection of claims 15-23, 27-28, and 33 is being appealed.

(iv) **Status of amendments.**

No amendments have been filed in the application following the final rejection mailed on January 22, 2010.

(v) **Summary of claimed subject matter.**

Claims 15, 16, 29, and 33 are independent claims. Claim 29 is allowed.

Independent Claim 15

The subject matter defined in independent claim 15 is an apparatus (1, 2) (*Fig. 1*) for releasing a magnetic security device (20) in an article (21) (*Specification*, ¶ [0006], lines 1-2).

The apparatus has a first portion (1) for locating the article in a first direction (D1) (*Specification*, ¶ [0020], lines 1-2). The apparatus also has a second portion (2) for locating the article in a second direction (D2) substantially perpendicular to the first direction (*Specification*, ¶ [0020], lines 2-5). The first and second portions define a receptacle (*Specification*, ¶ [0024], lines 1-2) configured and adapted to receive the article so as to physically restrain the article in the first and second directions as it is brought into contact with the first and second portions (*Specification*, ¶ [0006], lines 5-6), while leaving the article unrestrained in at least a third direction (D3) (*Specification*, ¶ [0022], line 1) substantially perpendicular to the first and second directions (*Specification*, ¶ [0006], line 8). The receptacle is configured and adapted to receive first and second surfaces (21A, 21B) of the article that are wider than the apparatus (*Specification*, ¶ [0023], line 1; ¶ [0024], lines 1-2), such that the article when received in the receptacle may extend beyond the apparatus in the third direction (D3) and may extend beyond the apparatus in a fourth direction opposite the third direction (*Fig. 1A*). At least one of the first and second portions includes magnetic release means (3, 4 and/or 23, 25) arranged to assist in locating the article, when the article is initially misaligned, into alignment in the third direction by magnetic attraction of the security device as the article is brought into contact with the at

least one of the first and second portions (*Specification*, ¶ [0006], line 6-10; ¶ [0037], lines 1-2; ¶ [0041], lines 5-7).). The magnetic release means are arranged to provide a first magnetic force in the first direction and a second magnetic force in the second direction for releasing the magnetic security device (20) from the article (21) (*Specification*, ¶ [0037], lines 1-2; ¶ [0041], lines 5-7).

Independent Claim 16

The subject matter defined in independent claim 16 is an apparatus (1, 2) (*Fig. 1*) for releasing a magnetic security device (20) in an article (21) (*Specification*, ¶ [0006], lines 1-2).

The apparatus has a first portion (1) for locating the article in a first direction (D1) (*Specification*, ¶ [0020], lines 1-2). The apparatus also has a second portion (2) for locating the article in a second direction (D2) substantially perpendicular to the first direction (*Specification*, ¶ [0020], lines 2-5). The first and second portions define an L-shaped receptacle (*Specification*, ¶ [0024], lines 1-2) configured and adapted to restrain the article in the first and second directions as it is brought into contact with the first and second portions (*Specification*, ¶ [0006], lines 5-6), while leaving the article unrestrained in at least a third direction (D3) (*Specification*, ¶ [0022], line 1) substantially perpendicular to the first and second directions (*Specification*, ¶ [0006], line 8). The L-shaped receptacle is capable of receiving articles of a wide range of shapes and sizes (*Specification*, ¶ [0023], line 1; ¶ [0024], lines 1-2), having a security device (20) installed adjacent two substantially perpendicular sides thereof (*Specification*, ¶ [0034], lines 5-9). The receptacle is configured and adapted to receive the article having first and second surfaces (21A, 21B) that are wider in the third direction than the apparatus (*Specification*, ¶ [0023], line 1; ¶ [0024], lines 1-2). At least one of the first and second portions

includes magnetic release means (3, 4 and/or 23, 25) (*Specification*, ¶ [0006], line 6-10; ¶ [0037], lines 1-2; ¶ [0041], lines 5-7) arranged to provide a first magnetic force in the first direction and a second magnetic force in the second direction for releasing the magnetic security device (20) from the article (21) (*Specification*, ¶ [0037], lines 1-2; ¶ [0041], lines 5-7). The receptacle is adapted and configured to receive the article such that the size of the surfaces of the article within the receptacle are unrestricted in at least the third direction and a fourth direction opposite the third direction (*Specification*, ¶ [0023-24]; *Fig. 1*).

Independent Claim 33

The subject matter defined in independent claim 33 is an apparatus (1, 2) for releasing a magnetic security device (20) in an article (21) (*Specification*, ¶ [0006], lines 1-2).

The apparatus includes a first portion (1) for locating the article in a first direction (D1) and second portion (2) for locating the article in a second direction (D2) substantially perpendicular to the first direction (*Specification*, ¶ [0020], lines 2-5). The first and second portions define a receptacle (*Specification*, ¶ [0024], lines 1-2) configured and adapted to receive first and second surfaces of the article (21A, 21B) such that the first and second surfaces of the article when received in the receptacle may extend beyond the apparatus in a third direction (D3) that is substantially perpendicular to the first and second directions, and may extend beyond the apparatus in a fourth direction opposite the third direction (*Specification*, ¶ [0006], lines 5-8). The apparatus also includes magnetic release means (3, 4 and/or 23, 25) associated with the receptacle for releasing the magnetic security device (20) in the article (21) (*Specification*, ¶ [0037], lines 1-2; ¶ [0041], lines 5-7).

(vi) **Grounds of rejection to be reviewed on appeal.**

The grounds of rejection to be reviewed on appeal include:

The anticipation rejection of independent claim 15 (and its dependent claims 17-20), independent claim 16 (and its dependent claims 27-28), and independent claim 33 under 35 U.S.C. § 102(b) in view of Farrar (U.S. Patent Application Publication 2004/0123311).

Note: The final office action does not include claim 33 in the initial listing of claims rejected under 102(b), but the claim is mentioned in the last paragraph of the 102(b) rejections and is therefore assumed to be rejected.

The obviousness rejection of dependent claims 21-23 in view of view of Farrar (U.S. patent Application Publication 2004/0123311, Kim (US Patent 6,880,372) and (for claims 22-23) Stelter (US Patent 6,084,498).

(vii) **Argument.**

35 U.S.C. § 102(b) Rejection of Claims 15 -20, 27-28, and 33

Independent claims 15, 16, and 33 stand rejected under 35 U.S.C. § 102(b) in view of Farrar (U.S. Patent Application Publication 2004/0123311). Applicant respectfully traverses this rejection and requests that the rejection be withdrawn and claims 15, 16, and 33 allowed.

Claim 15 is an independent claim that recites, in part, “a receptacle configured and adapted to receive the article so as to physically restrain the article in the first and second directions as it is brought into contact with the first and second portions, while leaving the article unrestrained in at least a third direction substantially perpendicular to the first and second directions, the receptacle being configured and adapted to receive first and second surfaces of the article that are wider than the apparatus, such that the article when received in the receptacle may extend beyond the apparatus in the third direction and may extend beyond the apparatus in a fourth direction opposite the third direction” (emphasis added).

Claim 16 is an independent claim that recites, in part, “an L-shaped receptacle configured and adapted to restrain the article in the first and second directions as it is brought into contact with the first and second portions, while leaving the article unrestrained in at least a third direction substantially perpendicular to the first and second directions, the L-shaped receptacle being capable of receiving articles of a wide range of shapes and sizes having a security device installed adjacent two substantially perpendicular sides thereof, the receptacle being configured and adapted to receive the article having first and second surfaces that are wider in the third direction than the apparatus” and “wherein the receptacle is adapted and configured to receive

the article such that the size of the surfaces of the article within the receptacle are unrestricted in at least the third direction and a fourth direction opposite the third direction” (emphasis added).

Claim 33 is an independent claim that recites, in part, “receptacle configured and adapted to receive first and second surfaces of the article such that the first and second surfaces of the article when received in the receptacle may extend beyond the apparatus in a third direction that is substantially perpendicular to the first and second directions, and may extend beyond the apparatus in a fourth direction opposite the third direction; and magnetic release means associated with the receptacle for releasing the magnetic security device in the article” (emphasis added).

Each of these claims has been rejected as anticipated for similar reasons, focusing on the claim language underlined above.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See, M.P.E.P. § 2131 (citing, *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). The Advisory Action alleges that “Farrar et al. does not disclose that magnetic release device 25 bounds the device in any other directions other than those established by parts 25A and 25B, leaving one to conclude that it is inherent within the cited passage that the third and fourth directions are not restrained in any manner.” The Advisory Action also states that the magnetic release device shown in figures 34-37 and the magnetic release device 25 are “two ... separate and distinct embodiments characterized by the use of different reference numerals. Moreover, the cross-section itself is not sufficient to conclude that the third and fourth directions are restrained.” (*See, Advisory Action, page 3, last 6 lines*)

Applicant respectfully disagrees. The Final Action alleges that Farrar's Figure 6 shows an apparatus that leaves an article unrestrained in at least a third direction (the "axial" direction). The apparatus in question is identified in paragraph [0104] of the published application as "magnetic release device 25." Except for paragraphs [0104], [0106] and [0109], element 25 is not otherwise discussed in Farrar (paragraph 114 incorrectly uses "25" to identify apertures "35" or "36".)

Farrar's Figure 6 is a cross section and depicts the local shape, not the overall shape, of "magnetic release device 25". The Action states that "Farrar et al. does not disclose that magnetic release device 25 bounds the device in any other directions other than those established by parts 25A and 25B, leaving one to conclude that it is inherent within the cited passage that the third and fourth directions are not restrained in any manner." To the contrary, Applicant asserts that the only thing one can conclude, from a cross section drawing such as Figure 6, is the local shape of the device at the location of the section. The cross section itself is not sufficient to conclude anything about any other portions of the device, including whether the third and fourth directions are unrestrained.

This is especially so because the only guidance Farrar gives with respect to this aspect of a release device is directly to the contrary. Elsewhere, Farrar paragraph [0082] states that "Fig. 34 is a perspective, part cut-away, view (from in front and beneath) of a preferred embodiment of apparatus for releasing a security member according to the invention..." (emphasis added). Figs. 34 and 35 show an apparatus comprising a "slot 501" for receiving an edge of the container. Fig. 36B shows the apparatus in one of several cross sections. One cannot conclude from Figure 36B that "it is inherent...that the third and fourth directions are not restrained in any manner," because Figs. 34 and 35 make clear that the article is not unrestrained in the third and

fourth directions. Figure 34 is identified as a preferred embodiment, and no other perspective drawings besides Figures 34 and 35 are shown to suggest other embodiments of an apparatus for releasing a security member.

There is no structure shown or described to suggest that the Fig. 6 represents anything other than a local cross-section view. Moreover, taking the disclosure as a whole, there is nothing in Farrar that shows or suggests a release device that leaves the article unrestrained in the axial direction. Given that the detailed embodiments show directly the contrary, to conclude that Fig. 6 suggests otherwise requires the hindsight of Applicant's own disclosure.

The failure of Farrar to disclose all of the elements of claim 15 precludes an anticipation rejection of claim 15, and this rejection should be withdrawn. Claims 17-20 depend from claim 15 and are therefore not anticipated because they depend from a non-anticipated independent claim, claim 15. For at least the foregoing reasons, the anticipation rejections of claims 17-20 should be withdrawn and the claims allowed.

For similar reasons, the failure of Farrar to disclose all of the elements of claim 16 precludes an anticipation rejection of claim 16. Claims 27-28 depend from claim 16 and are therefore not anticipated because they depend from a non-anticipated independent claim, claim 16. For at least the foregoing reasons, the anticipation rejections of claims 16 and 27-28 should be withdrawn and the claims allowed.

For similar reasons, the failure of Farrar to disclose all of the elements of claim 33 precludes an anticipation rejection of claim 33. For at least the foregoing reasons, the anticipation rejection of claim 33 should be withdrawn and the claim allowed.

35 U.S.C. § 103(a) Rejection of Claim 21-23

Claims 21-23 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Farrar (U.S. patent Application Publication 2004/0123311 and Kim (US Patent 6,880,372); and (for claims 22-23) in view of Stelter (US Patent 6,084,498). Applicant respectfully traverses this rejection and requests that the rejection be withdrawn and claims 21-23 be allowed.

Claims 21-23 depend from independent claim 15, which as discussed above is allowable. Applicant submits that claims 21-23 are therefore also allowable.

(viii) **Claims appendix.**

The following claims are appealed.

15. (Previously Presented) Apparatus for releasing a magnetic security device in an article, the apparatus comprising:

- a) a first portion for locating the article in a first direction;
- b) a second portion for locating the article in a second direction substantially perpendicular to the first direction;
- c) wherein the first and second portions define a receptacle configured and adapted to receive the article so as to physically restrain the article in the first and second directions as it is brought into contact with the first and second portions, while leaving the article unrestrained in at least a third direction substantially perpendicular to the first and second directions, the receptacle being configured and adapted to receive first and second surfaces of the article that are wider than the apparatus, such that the article when received in the receptacle may extend beyond the apparatus in the third direction and may extend beyond the apparatus in a fourth direction opposite the third direction; and
- d) at least one of the first and second portions including magnetic release means arranged to assist in locating the article, when the article is initially misaligned, into alignment in the third direction by magnetic attraction of the security device as the article is brought into contact with the at least one of the first and second portions, the magnetic release means being arranged to provide a first magnetic force in the first direction and a second

magnetic force in the second direction for releasing the magnetic security device from the article.

16. (Previously Presented) Apparatus for releasing a magnetic security device in an article, the apparatus comprising:
 - a) a first portion for locating the article in a first direction;
 - b) a second portion for locating the article in a second direction substantially perpendicular to the first direction;
 - c) wherein the first and second portions define an L-shaped receptacle configured and adapted to restrain the article in the first and second directions as it is brought into contact with the first and second portions, while leaving the article unrestrained in at least a third direction substantially perpendicular to the first and second directions, the L-shaped receptacle being capable of receiving articles of a wide range of shapes and sizes having a security device installed adjacent two substantially perpendicular sides thereof, the receptacle being configured and adapted to receive the article having first and second surfaces that are wider in the third direction than the apparatus; and
 - d) at least one of the first and second portions including magnetic release means arranged to provide a first magnetic force in the first direction and a second magnetic force in the second direction for releasing the magnetic security device from the article, wherein the receptacle is adapted and configured to receive the article such that the size of the surfaces of the article within the receptacle are unrestricted in at least the third direction and a fourth direction opposite the third direction.

17. (Previously Presented) Apparatus as claimed in claim 15 in which the first portion defines a first plane and the second portion defines a second plane substantially perpendicular to the first plane.
18. (Previously Presented) Apparatus as claimed in claim 17 in which the first and second planes define a receptacle having a substantially L-shaped cross-section.
19. (Previously Presented) Apparatus as claimed in claim 15 in which the first and second portions respectively comprise a base portion and a top portion upstanding therefrom.
20. (Previously Presented) Apparatus as claimed in claim 19 in which the first and second portions are connected together by means of at least one mutually engageable projection and recess.
21. (Previously Presented) Apparatus as claimed in claim 15 in which a first magnet mounted in the first portion provides the magnetic force in the first direction and a second magnet mounted in the second portion provides the magnetic force in the second direction.
22. (Previously Presented) Apparatus as claimed in claim 21 in which at least one of the first and second magnet comprises a plurality of parts which are held together in a configuration in which they tend to repel each other.
23. (Previously Presented) Apparatus as claimed in claim 22 in which at least one of the first and second magnets comprise a central part with a plurality of further parts adjacent thereto, the magnetic axes of each of the further parts being perpendicular to that of the central part.

27. (Previously Presented) Apparatus as claimed in claim 16 in which at least one of the first and second portions are arranged to assist in locating the article in a third direction substantially perpendicular to the first and second directions by magnetic attraction of the security device as the article is brought into contact with the first and second portions so as to align the magnetic security device with the magnetic release means.
28. (Previously Presented) A method of releasing a magnetic security device comprising the steps of providing an apparatus as claimed in claim 15 and presenting the article with the magnetic security device thereto to release the magnetic security device therefrom.
33. (Previously Presented) An apparatus for releasing a magnetic security device in an article, the apparatus comprising:
- a) a first portion for locating the article in a first direction and second portion for locating the article in a second direction substantially perpendicular to the first direction, the first and second portions defining a receptacle configured and adapted to receive first and second surfaces of the article such that the first and second surfaces of the article when received in the receptacle may extend beyond the apparatus in a third direction that is substantially perpendicular to the first and second directions, and may extend beyond the apparatus in a fourth direction opposite the third direction; and
 - b) magnetic release means associated with the receptacle for releasing the magnetic security device in the article.

(ix) **Evidence appendix.**

NONE.

- (x) **Related proceedings appendix.**

NONE.

Respectfully Submitted,

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